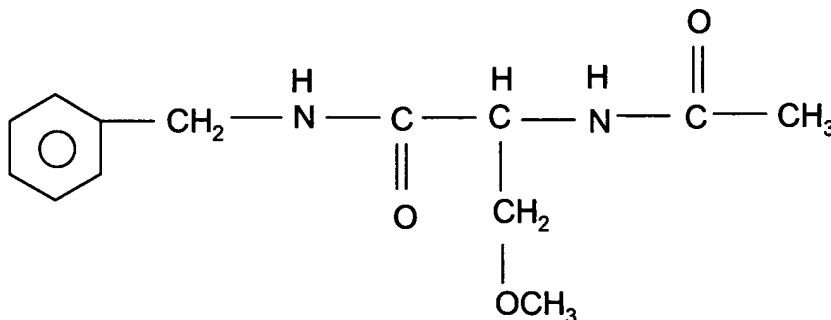


REMARKS

The Office Action has required the Applicant to elect under 35 U.S.C. §121 a disclosed species for prosecution on the merits, to which the claims will be restricted if no generic claim is finally held to be allowable.

In order to be responsive to the election requirement, Applicant provisionally elects, with traverse, the species (R)-N-Benzyl-2-acetamido-3-methoxypropionamide, which has the following structure:



i.e., in the compounds of Formula I,

R is benzyl, R₂ is hydrogen, R₃ is methoxymethyl, R₁ is methyl and n is 1.

Further, to be fully responsive to the election requirement imposed in the Office Action, Applicant respectfully submits that the following claims are readable on the elected species:

Claims 35, 36, 37, 38, 39, 40, 41, 42, 43, 47, 48, 49, 54, 57, 68, 69, 70, 71 and 72.

Nevertheless, applicant reserves the right to file a divisional application directed to any non-elected subject matter.

However, if this election is or becomes a Restriction Requirement, Applicant hereby traverses the requirement for restriction and requests reconsideration in view of the following Remarks.

Applicant respectfully submits that if this is a Restriction Requirement, the Restriction Requirement is not in compliance with 35 U.S.C. §121 and 37 C.F.R. §§1.141-1.142. 35 U.S.C. §121 provides that the Commissioner may restrict an application when “two or more independent and distinct invention are claimed in a single application.” (Emphasis added). Similarly, 37 C.F.R. §1.41(a) permits restriction conditioned upon a finding that independent and distinct inventions are found within one application.

If this is a Restriction Requirement, it is respectfully submitted that the Office Action has failed to comply with the statutory and regulatory requirements in imposing the Restriction Requirement. The Office Action has not shown that the application contains two or more independent and distinct invention, as required by 35 U.S.C. §121. In fact, it has not even alleged that the various species are independent and distinct, as required by 35 U.S.C. §121 and 37 C.F.R. §§1.141-1.142. Thus, the United States Patent and Trademark Office has not made out a prima facie case to support any restriction requirement that it may impose. Therefore, any Restriction Requirement resulting from this Office Action is improper and applicant respectfully requests that it be withdrawn.

Moreover, it is also noted that any Restriction Requirement resulting from this Office Action would not in compliance with MPEP §808. MPEP §808 states:

Every requirement to restrict has two aspects: (a) the reasons (as distinguished from the mere statement of conclusion) why the invention as claimed are either independent or distinct and (b) the reasons for insisting upon restriction therebetween.

The Office Action did not provide any reasons for potentially restricting the subject matter herein. In addition, it has not provided any reasons for insisting upon restriction

therebetween. Since the United States Patent and Trademark Office must comply with the MPEP, its failure to do so provides an additional basis for the impropriety of any Restriction Requirement resulting from the election of species.

In conclusion, the Office Action has not complied with the statute, regulations or the MPEP, if this election requirement is or becomes a Restriction Requirement. Therefore, applicant respectfully submits that any Restriction Requirement imposed as a result of the election of species requirement should be withdrawn, and Applicant respectfully requests that the United States Patent and Trademark Office examine all of the claims in the pending application.

Moreover, it is vital to all applicants that any Restriction Requirement imposed should issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double patenting. The third sentence of 35 U.S.C. §121, which states that a patent issuing on a parent application “shall not be used as a reference” against a divisional application or a patent issued thereon, does not provide comfort to applicants against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that 35 U.S.C. §121 protects a patentee from an allegation of same-invention double patenting, Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 228 U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of “obviousness-type” double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear

that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which an applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect a patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicants respectfully urge the Examiner not to require an election of species requirement in support of a restriction requirement in cases such as the present application wherein various aspects of a unitary invention are claimed.

In addition, the Courts have recognized the advantages to the public interest to permit patentees to claim all aspects of their invention, as the applicants have done herein, so as to encourage the patentees to make a more detailed disclosure of all aspects of their invention. The CCPA has observed:


We believe that the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner required by 35 U.S.C. §112 all aspects of what they regard as their invention, regardless of the number of statutory classes involved. (Emphasis added).

In re Kuehl, 456, F.2d 658, 666, 177 USPQ 250, (CCPA 1973).

Furthermore, applicant respectfully requests that in view of increased Official Fees and the potential limitation of applicant's financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive, and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts.

Hence, it is respectfully requested that the Examiner withdraw any Restriction Requirement imposed as a result of the election of species requirement, and provide an action on the merits with respect to all of the claims.

Respectfully submitted,


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